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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT PAPER NUMBER

3751

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,535

Applicant(s)

VIAL, SIEGBERT

Examiner

Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 10-13, 16-27, 30, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 12, 21-25, 27, 30 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10, 11, 13, 16-20, 26 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on September 8, 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.114 (a)(3) based on parent Application No. 09/889,535 is acceptable and an RCE has been established. An action on the RCE follows.

Drawings

2. In order to avoid abandonment, the drawing informalities noted on the "Notice of Draftsperson's Patent Drawing Review" (PTO-948) attached to the paper mailed on December 8, 2003 (Paper No. 15) must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "51" has been used to designate both spherical protrusions (note ¶0049, line 4, and Figs. 5A and 5D) and line-shape protrusions (note ¶0053, lines 1-2, and Fig. 5C). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because: (A) reference characters "41" and "42" have both been used to designate the same channel portion (note Figs. 2a, 2b, 7c, 7d, 8a and 8b); (B) reference characters "L", "13", "14" and "23" have

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both been used to designate the same bearing (note Figs. 2a, 3A, 3B, 3C, 3D, 4B and 4C); “29” and “10a” have both been used to designate the same opening in the tip device 10 (note Figs. 1b, 6a and 7a); reference characters “10” and “65a” have both been used to designate the same tip device (note Figs. 1a, 2b, 6a, 7a, 7b, 7c and 8a); and reference characters “65b” and “65e” have both been used to designate the same portion (note Figs. 6b and 6c). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters **not mentioned** in the description: (A) **8a** and **8b** (note Fig. 6a); and (B) **62** (note Fig. 6a). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference characters in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations

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indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

7. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino

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acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

8. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

9. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied**, such as, "The disclosure concerns", "The disclosure defined by this invention", "The disclosure describes", etc.

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10. The abstract of the disclosure is objected to because: (A) it refers to purported merits or speculative applications of the invention; (B) it uses phrases which can be implied, such as, “The invention relates to” and “the invention provides”; and (C) it uses reference characters. Correction is required. See MPEP § 608.01(b).

11. The disclosure is objected to because: (A) the specification fails to include the section entitled “Brief Summary of the Invention” but rather includes this summary under the section entitled “Prior Art”; (B) in the “Brief Description of the Drawings”, in ¶s 0033-0038, the lumping together of the description of the various figures is improper — each figure is required to have its own description as required by 37 CFR 1.74 and MPEP § 608.01(f); and (C) in ¶ 0047, on line 1, “said bearing 23, 14, 13” is confusing especially since no distinction is made to what distinguishes one from the other. Appropriate correction is required.

12. The following informalities in the specification are noted: (A) reference signs 9, 9a, 9b, 10, 13, 14, 17, 17', 20, 21, 22, 23, 25, 33, 34, 35, 40, 41, 42, 43, 50, 52a, 63, 63a, 64a, 64', 64", 65, 100, L and yl are inconsistently described in the specification in ¶s 0030-0035, ¶s 0036-0049, ¶s 0051-0052 and ¶ 0054-0066 — a careful paragraph by paragraph comparison is suggested; (B) in ¶0044, on line 8, “on” should be changed to read --in--; (C) in ¶0046, on line 4, “on” should be changed to read --in--; (D) in ¶0046, on line 6, “22a” should read --22--; (E) in ¶0048, on line 6, “on” should be changed to read --in--; (F) in ¶0049, on line 2, “on” should be changed to read --in--; (G) in ¶0049 the particular Fig. 5A, 5B, 5C, 5D or 5E should be indicated; (H) in ¶0053 the particular Fig. 5C should be indicated; and (I) in ¶ 0056, lines 13 and 15 contain two different descriptions of “65” and line 13’s “65” fails to correspond with the drawings (note Fig. 6b). Appropriate correction is required.

13. The specification is objected to as failing to provide proper antecedent basis for the claimed terminology. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed terminology which lacks such antecedent basis is as follows: (A) “a substantially sleeve-shaped shaft”, as called for by line 2 of claims 1, 30 and 34; (B) “a substantially conical tip device”, as called for

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by line 3 of claims 1, 30 and 34; (C) “said sleeve-shaped shaft”, as called for by line 7 of claims 1, 30 and 34; (D) “a leaf shaped spring”, as called for by line 10 of claim 1; (E) “a . . . spring is provided at a backwards facing end portion of said tip device, said spring extending into an inside of said shaft . . . for contacting an inner wall of said shaft”, as called for by lines 10-12 of claim 1; (F) “a bearing structure”, as called for by line 5 of claim 2; (G) “said bearing portion is located outside of said main axis or only one single bearing portion is associated to a sleeve wall of said shaft”, as called for by claim 35; (H) “said bearing portion also constituting a pivoting axis for varying the inclination angle of said tip device”, as called for by claim 35; (I) “on its edge, said tip device comprises limiting means for limiting maximum inclination portions by contacting protrusions . . . particularly such protrusions which are provided directly (integrally) with guiding means for laterally guiding said tip device”, as called for by claim 10; and (J) “said tip device has a conical shape and is at least partly symmetrical with respect to a cone axis”, as called for by claim 13. Correction is required. The specification can be amended to include this claimed terminology.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 1-5, 8, 10-13, 16, 17, 19-21, 23-27 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now calls for the leaf shaped spring being provided “for effecting a resetting force upon an increase of said inclination angle of said tip device, increasing when said control increases the pivot action of the tip device”. However, the originally filed disclosure merely describes and supports “A returning force, moving said tip

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from its changed inclined position back to a straight position, may be obtained by ... a spring means applying a force component on said tip device, such that a torque around a bearing position of said tip device at the shaft is generated, said torque urging said tip device back into its basic position” (note lines 1-5 of ¶ 0009). Therefore the originally filed disclosure fails to support that the leaf spring effects such a resetting force upon such an increase of said inclination angle of said tip device and increasing when the control increases the pivot action of the tip device. Hence, claims 1-5, 8, 10-13, 16, 17, 19-21, 23-27 and 35 are directed to new matter.

16. Claims 2 and 3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “in this embodiment a refilling device 40 being provided in said shaft 20, said refilling device being supported at the backwards facing end at said terminal part 50, and comprising a writing tip 30 at the front end, a channel portion 41, 42, which has a considerably smaller diameter, leading into a step or shoulder portion 43, having a diameter corresponding to a so-called ‘high capacity’ or ‘large volume’ ink device or cartridge for storing a writing liquid.” (note lines 2-7 of ¶ 0042), does not reasonably provide enablement for “one of an ink device and a refilling device (40) received in said shaft”, as called for by claim 2, and “a refilling device (40) for containing ink”, as called for by claim 3. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

17. Claim 3 is also rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “Upon inclining said tip, an elastic portion 42 of said refilling device bends out under application of a returning force, so that, upon a returning movement of said refilling device, said tip reduces its inclination achieved before” (note lines 1-3 of ¶ 0045), does not reasonably provide enablement for “an elastically flexible portion (42) at a front end thereof, said portion changing at least one of a deflection and a bending stress thereof, upon changing of said inclination angle (α)”, as called for by claim 3. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

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18. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “Upon inclining said tip, an elastic portion 42 of said refilling device bends out under application of a returning force, so that, upon a returning movement of said refilling device, said tip reduces its inclination achieved before.” (note lines 1-3 of ¶ 0045), does not reasonably provide enablement for “wherein, at its front end, said elastically flexible portion is adapted as a writing tip, said writing tip protruding through a front end opening of said tip device to make use of said bending stress of said elastically flexible portion for effecting a returning force on said tip device having said adjustable inclination angle”, as called for by claim 4. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

19. Claims 5 and 35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “said tip is arranged to be inclinable, tiltable or pivotable at a bearing L offset with respect to said axis 100” (note lines 4-6 of ¶ 0043), does not reasonably provide enablement for “wherein said tip device is pivotably received at a bearing portion at said shaft”, as called for by claim 5, and “said bearing portion is located outside of said main axis or only one single bearing portion is associated to a sleeve wall of said shaft, said bearing portion also constituting a pivoting axis for varying the inclination angle of said tip device”, as called for by claim 35. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

20. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “shoulder 43 is in contact with a contour control portion 9 comprising two webs at the backward facing end of said tip device” (note lines 2-3 of ¶ 0044) and “said front step or shoulder 43, as an annular surface at a contact position with the rear end of said conical tip 10 transfers a pivoting movement on said tip, when said tip is arranged to be inclinable, tiltable or pivotable at a bearing L offset with respect to said axis 100.” (note lines 3-6 of ¶ 0043), does not reasonably provide enablement for “wherein a coupling portion is provided at an

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end portion of said tip device, said coupling portion being offset in relation to said bearing portion in said plane comprising said main axis”, as called for by claim 8. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

21. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “Two laterally protruding limiting means 12 are provided, said means being offset by $\pm 90^\circ$ in relation to said bearing portion 23 and providing a limiting position of said tip device 10 at further limiting means 21a, 22a, located correspondingly inside said shaft and at a forward facing end thereof, said limiting means 21a, 22a being visible on figure 4. When said conical tip device 10 reaches its maximum inclination, said two noses contact said protrusions 21, 22a and limit a further pivoting movement; at said state of inclination, the shoulder 43 of said refilling device 40 is also in a plane-parallel contact with said portion 9b of said inclined contour control 9.” (note ¶ 0046), does not reasonably provide enablement for “wherein, on its edge, said tip device (10) comprises limiting means (12), for limiting maximum inclination portions by contacting protrusions (21a, 22a) located at the inside of said shaft, particularly such protrusions which are provided directly (integrally) with guiding means (21, 22) for laterally guiding said tip device (10).”, as called for by claim 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

22. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “Said bearing comprises two opposite protrusions, one being located at the front end of said shaft and at the inside thereof, the other being arranged at an outer and backwards facing end of said conical tip, so that said two protrusions form a bearing portion L or 23 for a conical tip device 10 being inserted from the rear” (note lines 6-9 of ¶ 0043), does not reasonably provide enablement for “said tip device is received at an inside and at a front end of said shaft, said tip device being particularly adapted to be inserted into said shaft from a rear end portion thereof”, as called for by claim 11. The specification does not enable any person skilled

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in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

23. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a conical tip device 10 comprising control portions 9, 9a, 9b at the backward facing portion as well as further elements for improving the functionality of the variable inclination of said tip device 10” (note ¶ 0033) and “Said pivoting movement is initiated by the described longitudinal adjustment of said ink device 40. Said shoulder 43 is in contact with a contour control portion 9 comprising two webs at the backward facing end of said tip device” (note lines 1-3 of ¶ 0044), does not reasonably provide enablement for “said tip device (10) comprises a rear end portion (9; 9a, 9b) cooperating with a shoulder portion (43, 66b) of a refilling device (40), for providing a contour control for changing the inclination angle of said tip device”, as called for by claim 16. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

24. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “Said pivoting movement is initiated by the described longitudinal adjustment of said ink device 40. Said shoulder 43 is in contact with a contour control portion 9 comprising two webs at the backward facing end of said tip device, which webs may have a semicircular or a straight shape. In a direction perpendicular to said main axis 100, said webs have a spherical shape or comprise two web pieces, each of which having a straight extension, but at an angle differing from 180°. Said inclined extension 9a, 9b corresponds to a substantially desired maximum inclination of said cone 10, so that an angle β illustrated on figure 3 substantially corresponds to said angle α_{\max} of figure 1.” (note ¶ 0044), does not reasonably provide enablement for “a contour control means (9) is provided at said tip device, said contour control means comprising at least one web segment, comprising two web portions (9a, 9b) extending to form an angle (β) of less than 180°, for controlling the inclination angle of said tip device”, as called for by claim 17. The specification does not enable any person skilled in the art

to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

25. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “said webs have a spherical shape or comprise two web pieces, each of which having a straight extension, but at an angle differing from 180°. Said inclined extension 9a, 9b corresponds to a substantially desired maximum inclination of said cone 10, so that an angle β illustrated on figure 3 substantially corresponds to said angle α_{\max} of figure 1.” (note lines 5-9 of ¶ 0044), does not reasonably provide enablement for “wherein a kink angle (β) of said web portions (9a, 9b) substantially corresponds to a maximum inclination angle (α_{\max}) of said tip device (10) relative to said main axis (100)”, as called for by claim 19. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

26. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “A number of embodiments for realizing a terminal part 50 are accessible to the expert on figure 5. An embodiment of realizing a longitudinal movement x of a refilling device 40 is to provide said terminal part 50 as a stopper or plug which when turned using tab 50b, is guided in a thread by one or two opposite spherical protrusions 51, so that a rotary movement of said plug or stopper 50 effects its longitudinal movement.” (note lines 1-6 of ¶ 0049) and “A terminal part according to figure 5 is provided with protrusions 51, which, according to illustration C may have a line-shape. They may also be locked in corresponding lock-in positions 52 at the inside of said shaft for fixing predetermined positions upon a rotary movement, said positions corresponding to defined angle positions α of said tip device.” (note lines 1-5 of ¶ 0053), does not reasonably provide enablement for “said terminal part (50) of the shaft is rotatably received in said shaft (20), and wherein rotation of the terminal part is restricted by one of tightness and provision of circumferential lock-in positions (52)”, as called for by claim 18. The specification does not enable any person skilled in the art to which it pertains, or

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with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

27. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a conical tip device 10 comprising control portions 9, 9a, 9b at the backward facing portion” (note lines 2-3 of ¶ 0033), does not reasonably provide enablement for “said tip device is provided with at least one coupling means (9; 9a, 9b) at a backwards facing end portion”, as called for by claim 20. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

28. Claim 20 is also rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “Supposed that said ink device 40 moves in a longitudinal direction x, in parallel to said main axis 100, and over a small distance in a forward and a backward direction, said front step or shoulder 43, as an annular surface at a contact position with the rear end of said conical tip 10 transfers a pivoting movement on said tip, when said tip is arranged to be inclinable, tiltable or pivotable at a bearing L offset with respect to said axis 100.” (note lines 1-6 of ¶ 0043) and “Said pivoting movement is initiated by the described longitudinal adjustment of said ink device 40. Said shoulder 43 is in contact with a contour control portion 9” (note lines 1-2 of ¶ 0044), does not reasonably provide enablement for “a shoulder (43, 66d) of a refilling device (40, 65) being coupled to said coupling means, for applying forces on said tip device (10), said forces controlling the inclination angle (α) of said tip device”, as called for by claim 20. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

29. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a refilling device 40 being provided in said shaft 20” (note line 2 of ¶ 0042), “Figures 8 comprise two illustrations of a writing instrument having a closed end 20b, an axial position of a rear shaft part 20" being changed relative to a front shaft part 20', said change

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being effected by a connection having a thread pitch 20w. Said shaft is divided in two parts, the dividing position according to this embodiment being located at a front third part" (note lines 1-5 of ¶ 0064), "According to this embodiment, a front end 20c of a rear shaft part 20" ... Advancing said end 20c causes a direct mechanical coupling of a force, said force initiating a tip inclination 10 relative to said bearing portion L with the corresponding lever arm." (note lines 1-5 of ¶ 0065) and "Said double stroke of said refilling device 65 for achieving the same angle of said tip device 10 is compensated by a spring 41b between said closed end 20b and an end of said refilling device 65. Said spring urges said refilling device 65 further to the front, when said distance 27 is increased, thus maintaining the contact or the coupling between said shoulder 43 and said coupling portion 9. A pressure on the refilling device caused by writing is absorbed by said spring 41b, such that practically no axial displacement occurs and the refilling device protrudes out of said tip device at an equal length, independent of the writing pressure and the angle position." (note lines 1-8 of ¶ 0066), does not reasonably provide enablement for "an axially extending refilling device (40, 65) is provided, and wherein a first elastic force acts on said refilling device by an axially acting spring means (41a, 41b), for axially pretensioning said refilling device one of towards said tip device (10) and away from said tip device (10)", as called for by claim 21. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

30. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "Figures 8 comprise two illustrations of a writing instrument having a closed end 20b, an axial position of a rear shaft part 20" being changed relative to a front shaft part 20', said change being effected by a connection having a thread pitch 20w. Said shaft is divided in two parts, the dividing position according to this embodiment being located at a front third part, ... Similar to adjusting a distance x1, x2, a distance y1, y2 is adjustable in this embodiment for controlling a tip inclination 10 from a shaft." (note lines 1-8 of ¶ 0064), does not reasonably provide enablement for "a length of one of said shaft (20; 20'; 20'') and said writing

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instrument (10, 20, 35, 33) varies with variation of said inclination angle (α) of said tip device (10)", as called for by claim 23. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

31. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "A returning force, moving said tip from its changed inclined position back to a straight position, may be obtained by providing an elastic portion of a refilling device or cartridge arranged in said shaft axis or a spring means applying a force component on said tip device, such that a torque around a bearing position of said tip device at the shaft is generated, said torque urging said tip device back into its basic position." (note ¶ 0009), does not reasonably provide enablement for "a refilling device (65) tensioned by a compression spring (41b) such that said refilling device is urged against said tip device (10), said compression spring being dimensioned such that it receives writing forces without substantially changing a position of said refilling device (65), but effects a smaller torque on the tip device (10) than a returning force of a further elastic means (42, 17) said elastic means being also coupled to said tip device (10) to allow the tip device to be pivoted back into a straight position with respect to said main axis (100)", as called for by claim 24. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

32. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "A push button 35 changes the position of said refilling device, the design of the tip device and the bearing L being similar to that described before with reference to the figures. Additionally, an axial spring 41a is arranged, being in contact with the front portion of a tapered channel of the tip opening and also with a shoulder according to 66c of figure 6b, for spacing said shoulder 43 from said contour control 9 in a retracted position." (note lines 3-8 of ¶ 0060), does not reasonably provide enablement for "a refilling device (40) elastically tensioned by a spring (41a) in relation to said tip device (10), and wherein a second elastic force is applied

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to said tip device (10) at least sufficient to compensate for a torque applied by said spring (41a)", as called for by claim 25. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

33. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "Said pivoting movement is initiated by the described longitudinal adjustment of said ink device 40. Said shoulder 43 is in contact with a contour control portion 9 comprising two webs at the backward facing end of said tip device, which webs may have a semicircular or a straight shape. In a direction perpendicular to said main axis 100, said webs have a spherical shape or comprise two web pieces, each of which having a straight extension, but at an angle differing from 180°. Said inclined extension 9a, 9b corresponds to a substantially desired maximum inclination of said cone 10, so that an angle β illustrated on figure 3 substantially corresponds to said angle α_{\max} of figure 1." (note ¶ 0044), does not reasonably provide enablement for "means (43, 9, 63, 50) for controlling and adjusting said inclination angle (α) of said tip device", as called for by claim 26. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

34. Claim 26 is also rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "when no refilling device with elastic portion is provided ... in which writing instrument a refilling device may simply be inserted from the rear" (note lines 5-8 in ¶ 0020), does not reasonably provide enablement for "and independently thereof, a further means for opening of said writing instrument whereby a refilling device can be inserted", as called for by claim 26. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

35. Claim 26 is further rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 26 calls for “whereby a refilling device can be ... exchanged”. However, the originally filed disclosure fails to support or describe that the refilling device can be exchanged. Therefore, claim 26 is drawn to new matter.

36. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

37. Claims 1-5, 8, 35, 10, 11, 13, 16, 17-20, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

38. Claim 1 calls for the spring “for contacting an inner wall of said shaft”. However, the drawings merely show and support that the spring contacts an inner wall surface of the shaft. Therefore, it is unclear as to what structure is intended by “an inner wall of said shaft”.

39. Claim 1 contains terms lacking proper antecedent basis. The claim recites the limitations “said control” in lines 13-14 and “the pivot action” in line 14. There is insufficient antecedent basis for these limitations in the claim.

40. Regarding claim 2, it is unclear how the changing of the inclination recited therein is structurally related to the control of the inclination recited in claim 1.

41. Claim 8 contains a term lacking proper antecedent basis. The claim recites the limitation “said plane” in line 4. There is insufficient antecedent basis for this limitation in the claim.

42. Regarding claim 10, the phrase “particularly such” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Additionally, the phrase “directly (integrally)” likewise renders the claim indefinite since it is unclear if an integral formation of the protrusions is being claimed.

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43. Regarding claim 11, the phrase “particularly adapted” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

44. Claim 18 is incomplete since it depends from a cancelled claim, i.e., claim 31. Therefore, the metes and bounds of what is being claimed cannot be determined. To advance prosecution, claim 18 has been further construed as depending from claim 1.

45. Claim 18 contains terms lacking proper antecedent basis. The claim recites the limitations “said terminal part (50) of the shaft” in line 2 and “the terminal part” in line 3. There is insufficient antecedent basis for these limitations in the claim.

46. In claim 25, “a second elastic force” in line 3 is indefinite since a first elastic force has not been recited.

Claim Rejections - 35 USC § 103

47. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

48. Claims 1-5, 8, 35, 10, 11, 13, 16, 17, 19, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garvey in view of Krannak. Garvey discloses a writing or inscribing instrument having the claimed features including a sleeve-shaped shaft A, a main axis (note the axis formed by parts A, C and B in Fig. 1), a terminal part at a rear end portion of the shaft A (note the top end of shaft A in Fig. 1), a substantially conical tip device (constituted by lower member B as shown in Fig. 1) at a front end portion of the shaft A, the tip device being variably inclinable to an inclination (note Fig. 5) by being controlled by the pressure applied to the tip (note lines 45-48 on page 2) and tiltable or pivotable or inclinable (note lines 36-38 on page 2) in a pivot plane comprising the main axis and relative to the sleeve-shaped shaft A (note Fig. 5),

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and an inclination angle (α) of a cone axis of the tip device B being adjustable in relation to the main axis (note Fig. 5 and lines 32-48 on page 2), and wherein a spring 13 is provided at a backwards facing end portion of the tip device (note Figs. 2 and 5), the spring 13 extending into an inside of the shaft A for contacting an inner wall of the shaft A and for effecting a resetting force upon an increase of the inclination angle of the tip device B, increasing when the control increases the pivot action of the tip device B. Garvey also discloses that the shaft/reservoir A has a fluid discharge opening 3 and a fluid regulating valve 4 for regulating the flow of fluid through the opening 3, the fluid regulating valve 4 being biased by one end of spring 13. Although Garvey fails to teach the use of other springs that are alternative to the coiled spring (as shown), attention is directed to Krannak who discloses another fluid container reservoir having a valved discharge mechanism in which the valve can include a coiled spring 19 (note Fig. 1) or a leaf spring 25 (note Fig. 3) as functional equivalents. In view of the teaching of Krannak, it would have been obvious to one of ordinary skill in the fluid container reservoir art, at the time the invention was made, to employ a leaf spring for the coiled spring on the Garvey device wherein so doing would constitute substitution of functional equivalents that would work equally well on the Garvey device. With respect to claim 2, Garvey also discloses that the inclination angle is changed from the terminal part (note lines 44-48 on page 1) providing a longitudinal movement of the ink device constituted by the reservoir in shaft A (note Fig. 5 and line 67 on page 1) with the longitudinal movement being effected in a longitudinal direction and relative to a socket or bearing (constituted by the tip holder member C, stem 10 and valve 4) between the tip device B and the shaft A. With respect to claim 3, Garvey further discloses that the shaft A constitutes a reservoir or refilling device for containing ink (note lines 29-31 and 93 on page 1) comprising an elastically, i.e., sufficiently resilient to return to its original condition, flexible portion 5 (note line 75 on page 1 and Figs. 1, 2 and 5) at a front end thereof (note Figs. 1, 2 and 5), the portion 5 changing at least one of a deflection and a bending stress thereof (note Fig. 5) upon changing of the inclination angle (α). With regard to claim 4, Garvey additionally discloses that at its front end, the flexible portion 5 is adapted as a writing tip that protrudes through a front end opening

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of the tip device B (note Fig. 5) to make use of the bending stress of the flexible portion 5 for effecting a returning force on the tip device B having the adjustable inclination angle. With regard to claim 5, Garvey also discloses that the tip device B is pivotably received at a bearing portion at the shaft A (note Fig. 5). With regard to claim 8, Garvey further discloses a coupling portion C provided at an end portion of the tip device B with the coupling portion C being offset in relation to the bearing portion in a plane comprising the main axis (note Figs. 2 and 5). With regard to claim 35, Garvey additionally discloses that the bearing portion is located outside of the main axis (note Figs. 2 and 5) with the bearing portion also constituting a pivoting axis for varying the inclination angle of the tip device B (note Fig. 5). With respect to claim 10, Garvey also discloses that the tip device B, on its inner edge, comprises limiting means (constituted by stem 10) for limiting maximum inclination portions by contacting protrusions located at the inside of the shaft (note Fig. 5). With respect to claim 11, Garvey further discloses that the tip device B is received at an inside end (at the stem 10) and at a front end of the shaft A (note Fig. 5). With respect to claim 13, Garvey additionally discloses that the tip device B has a conical shape and is at least partly symmetrical with respect to a cone axis (note Figs. 1 and 2). With regard to claim 16, Garvey also discloses that the tip device B comprises a rear end portion (constituted by upper member C) cooperating with a shoulder portion (constituted by the laterally extending flange of the valve housing 1) of a refilling device (constituted by the reservoir in shaft A) for providing a contour control for changing the inclination angle of the tip device B (note Fig. 5). With regard to claim 17, Garvey further discloses that a contour control means (constituted by upper member C) is provided at the tip device B, the contour control means C comprising at least one web segment (note Fig. 4) comprising two web portions (constituted by the portions between any two adjacent holes 11, note Fig. 4) extending to form an angle of less than 180° for controlling the inclination angle of the tip device B (note Fig. 5). With regard to claim 19, Garvey additionally discloses that an angle of the web portions substantially corresponds to a maximum inclination angle of the tip device B relative to the main axis (note Fig. 5). With regard to claim 20, Garvey also discloses that the tip device B is

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provided with at least one coupling means (constituted by stem 10) at a backwards facing end portion, a shoulder (constituted by the laterally extending flange of the valve housing 1) of a refilling device (constituted by the reservoir in shaft A) being coupled to the coupling means 10 for applying forces on the tip device B, the forces controlling the inclination angle of the tip device B (note Fig. 5). With respect to claim 26, Garvey further discloses a means (constituted by the laterally extending flange of the valve housing 1) for controlling and adjusting the inclination angle of the tip device B (note Fig. 5), and independently thereof, a further means (constituted by extension 2 for permitting an opening of the writing/inscribing instrument) for opening the writing/inscribing instrument whereby the refilling device (constituted by the reservoir in shaft A) can be inserted.

49. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garvey in view of Krannak, as applied to claims 1-5, 8, 35, 10, 11, 13, 16, 17, 19, 20 and 26 above, and further in view of Rosenthal. Although Garvey fails to disclose that a terminal part of the shaft A is rotatably received in the shaft and that the rotation is restricted by tightness, attention is directed to Rosenthal who discloses another writing instrument having a shaft or cylindrical body 16 provided with a terminal part or closure 17 (note Fig. 2) which is rotatably received in the shaft or cylindrical body 16 (note lines 66-70 in col. 1) in order to be detachable from the shaft or cylindrical body 16 so as to replenish the supply of ink (note lines 62-65 in col. 2) and which rotation is restricted by the use of tightness with a gasket 25 (note lines 70-72 in col. 1). It would have been obvious to one of ordinary skill in the writing/inscribing instrument art, at the time the invention was made, to form the shaft A of Garvey with a separate terminal part or closure which is rotatably received in the shaft and is restricted in its rotation by use of a gasket in view of the teachings of Rosenthal in order to form a part or closure which is removable or detachable from the shaft so that the supply of ink can be readily replenished.

Election/Restrictions

50. Claims 12, 21-25, 27, 30 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 8, 2003.

Response to Arguments

51. Applicant's arguments filed September 8, 2004 have been fully considered but they are not deemed persuasive.

52. Applicant's arguments regarding the use of reference characters 41 and 42 have been carefully considered. However, using two different reference characters to indicate the same channel structure is improper no matter how that structure is described.

53. Applicant's arguments regarding the specific claim language versus the language used in the originally filed disclosure have been carefully considered. However, it is suggested that the claims use the language in the originally filed disclosure in order to comply with 35 USC § 112, first paragraph.

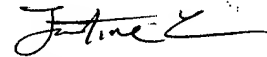
Conclusion

54. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Kathleen J. Prunner, whose telephone number is 571-272-4894.

55. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu, can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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56. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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11/10/05



Kathleen J. Prunner

November 8, 2005